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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/440,260	11/15/1999	ARTHUR JOST	GEN-067	2733

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EXAMINER

KOENIG, ANDREW Y

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 10/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/440,260

Applicant(s)

JOST ET AL.

Examiner

Andrew Y Koenig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 30 June 2003 have been fully considered but they are not persuasive.

Regarding claims 1, 11, and 20, the applicant argues, "Caporizzo fails to teach or suggest anything about how those identification numbers are generated (see page 10, lines 5-7)." The examiner agrees, but notes that the claims do not recite any limitation indicating how the identification numbers are generated. Regardless of how the identification number of the terminal of Caporizzo is determined, there is no limitation directed to this feature.

The applicant argues, "Caporizzo does not teach or suggest a system controller that 'automatically determin[es] which upstream plant of a plurality of upstream plants transmits a first message to said system controller from a particular set top terminal' (see page 10, lines 8-10)." The examiner disagrees; Caporizzo teaches a first message containing 217784 received at the headend. The headend (claimed system controller) automatically determines which upstream plant of a plurality of upstream plants transmits the message by deciphering the message, in this case the 2 is the trunk number, 1 is the line extender, and 7784 is the set top serial number. Accordingly, Caporizzo teaches automatically determining which upstream plant of a plurality of upstream plants transmits a first message. Whereas, the invention of the instant application performs a different method for determining upstream plants, the claim is broad enough to read on the given interpretation.

The applicant argues, "Caporizzo fails to teach or suggest 'identifying a downstream plant associated with the upstream plant that transmits said first message from said set top terminal.' (see page 10, lines 10-12)." The examiner disagrees; Caporizzo teaches identifying the trunk number (40) and the line extender (label 34), which it is noted is the information identifies the downstream plant associated with the upstream plant.

Regarding claims 3, 13, and 22, the applicant argues, "Caporizzo fails to teach or suggest assigning attributes based on a terminal's physical location." The examiner disagrees; Caporizzo clearly teaches authorizing access to channel by subscribing to or paying for services (col. 3, ll. 3-5), further the examiner notes that if any changes are made to the set top terminal at the user's home, they are performed "based on said location of the said set top terminal" in order to permit the user to receive additional services. The examiner notes that the claims are broader than that argued.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 25 and 28-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. Dependent claim 25 and independent claim 28 recite the limitation "selling a set-top terminal." The specification, on page 16, lines 4-17, discloses purchasing and installation of set-top terminals by consumers; but does not convey a method of selling; but merely the user purchasing.

For the rest of the Office Action "selling a set top terminal" will be interpreted as a subscriber purchasing the set top terminal.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 7-13, 16-18, 20-22, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,574,495 to Caporizzo.

Regarding claims 1, 11, and 20, Caporizzo teaches a cable television system which assesses the noise in the channels and notifies the headend of problems (abstract). Caporizzo teaches a headend (claimed system controller), a population of terminals, and a plurality of upstream and downstream plants (fig. 1). Furthermore, the system of Caporizzo can locate set top terminals within a system by maintaining a system topology of devices (col. 6, ll. 4-13). Caporizzo teaches sending a message

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containing bit error rate (BER) information to the headend (col. 5, ll. 37-39), which reads on sending a first message to the system controller from a set top terminal.

Furthermore, by using the CATV network topology, the system can determine the upstream plant and the downstream plant associated with the terminal (col. 6, ll. 4-13).

The examiner notes that the identification is 217784, where 2 is the trunk number, 1 is the line extender and 7784 is the set top terminal. Accordingly, the location of the set top terminal within the system comprises an identification of the upstream and downstream plants.

Regarding claims 2, 12, and 21, Caporizzo teaches transmitting a request message from the headend (claimed system controller) to a set top terminal (col. 5, ll. 4-11), accordingly, the set top terminal responds to the request message (col. 5, ll. 37-48).

Regarding claims 3, 13, and 22, Caporizzo teaches authorizing access to specific services and channels (col. 3, ll. 3-5), which reads on assigning attributes for set top terminals. The examiner notes that by assigning characteristics to a particular set top terminal, the set top terminal has a location. Accordingly, Caporizzo teaches, "assigning attributes for said set top terminal based on said location of said set top terminal" as claimed.

Regarding claims 7 and 16, Caporizzo teaches a demand from the set top terminal (col. 5, ll. 4-11), which reads on a set top terminal transmitting a message without receiving a request message from the controller.

Regarding claims 8 and 17, Caporizzo teaches a subscriber demand initiating the data accumulation procedure, which in turn transmits the first message (col. 5, ll. 5-8).

Regarding claims 9 and 18, Caporizzo teaches identifying a trunk and line extender along with the set top terminal in order to identify the a group of malfunctioning devices (col. 6, ll. 5-13).

Regarding claims 10 and 19, Caporizzo teaches using a phone line to send the information the headend (claimed controller) (col. 5, ll. 43-48). By completing this action, the system of Caporizzo clearly must call use a telephone network that in turn reads on the claimed upstream plant.

Regarding claim 24, Caporizzo teaches providing physical and logical topology information for the system based on the location information of the terminal (col. 6, 4-13).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 5, 14, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,574,495 to Caporizzo in view of U.S. Patent 6,463,588 to Jenkins et al. and U.S. Patent 6,425,132 to Chappell.

Regarding claims 4, 14, and 31 Caporizzo teaches associating attributes to the set top terminals, but is silent on associating attributes with each upstream and downstream plant. Jenkins teaches associating a status for end user devices in the downstream data path (col. 2, ll. 22-37, col. 2-3, ll. 56-6). In the upstream direction, Chappell teaches identifying a node, with a node identifier (col. 5-6, ll. 65-1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caporizzo by associating attributes with both the downstream and upstream plants as taught by Jenkins and Chappell in order to analyze the network and improve the efficiency of the system.

Regarding claims 5 and 32, Caporizzo is silent on associating attributes for the terminal based on the upstream path. Official Notice is taken that associating attributes for the terminal based on the upstream path is well known. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caporizzo by associating attributes based on the upstream path in order to adjust the power, timing and other transmission characteristics for the set top terminal thereby transmitting data more efficiently.

9. Claims 6, 15, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,574,495 to Caporizzo in view of U.S. Patent 5,563,883 to Cheng.

Regarding claims 6, 15, and 33, Caporizzo teaches polling from both the headend or the set top terminal either simultaneously or to addressed terminals (col. 5, ll. 4-11). By polling a particular set top terminal, the terminal clearly has a location.

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However, Caporizzo is silent on teaching selecting terminals to minimize collisions.

Cheng teaches grouping terminals in order to minimize collisions (col. 11, ll. 9-14).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caporizzo by grouping terminals to minimize collisions as taught by Cheng in order to provide a more reliable upstream data path.

10. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,574,495 to Caporizzo.

Regarding claims 23 and 26, Caporizzo teaches a set top terminal demanding when the terminal has been added to the system. Official Notice is taken that performing an action once connected to the network is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to perform a demand of Caporizzo once connected to the network in order to identify the device to the network.

Regarding claim 25, Caporizzo is silent on purchasing a set top terminal. Official Notice is taken that purchasing a set top terminal is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caporizzo to purchase a set top terminal in order to enable a user to integrate a device into the network thereby gaining functionality and services available on the network.

Regarding claim 28, the limitations of claim 28 have been addressed in the discussion of claims 1, 25, and 26.

Regarding claims 29, 30, and 34-36, the limitations of claims 29 and 30 have been addressed in the discussion of claims 2, 3, 7-9, respectively.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y Koenig whose telephone number is (703) 306-0399. The examiner can normally be reached on M-Th (7:30 - 6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



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